

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDGAR A. DALLAS
and
PETER B. WHITLOCK

Appeal No. 2002-0993
Application 09/368,781

ORDER REMANDING TO EXAMINER

On July 23, 2001, appellants filed a Notice of Appeal (Paper No. 11) "from the final decision of the Examiner rejecting Claims 1-5, 8-11, 14-16, 19-25, 27, 28, and 37-44 and withdrawing claims 45-49 of the above-referenced application." The Appeal Brief filed September 21, 2001 (Paper No. 16) agreed with the above statement but noted that "the Examiner . . . withdrew the restriction between the embodiments of FIGS. 8-10 [and] Applicant therefore submits that claims 45-49 are now pending for purposes of this appeal" (page 2, "Status of Claims"). The Examiner's

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Answer mailed November 30, 2001 (Paper No. 18) corrected the status of claims contained in the Appeal Brief filed September 21, 2001 (Paper No. 16) by noting that "[t]his appeal involves claims 1-5, 8-11, 14-16, 19-25, 27-28, [and] 35-44" and that "[c]laims 45-49 stand withdrawn from consideration as not directed to the elected species" (page 2 under the heading "Status of Claims") (emphasis added). It should be noted, however, that the Appeal Brief (Paper No. 16 filed September 21, 2001) and Examiner's Answer (Paper No. 18 mailed November 30, 2001) fail to include claims 14 and 44 in a rejection.

In addition, a supplemental Information Disclosure Statement (IDS) was filed December 19, 2000 (Paper No. 7). It is not apparent from the record whether the examiner considered the second page of the IDS or notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Accordingly, it is

ORDERED that the application is remanded to the
Examiner:

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1. for a determination regarding the status of claims 14 and 44;
2. for consideration of the second page of the IDS filed December 19, 2000 (Paper No. 7) and appropriate written notification to appellants regarding the Examiner's decision; and
3. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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